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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/829,943  | 04/11/2001  | Holger Glaum         | 204205US0           | 7697             |
| 22850   | 7590        | 10/24/2003           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | WOOD, ELIZABETH D   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1755                |                  |

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/829,943

Applicant(s)

GLAUM ET AL.

Examiner

Elizabeth D. Wood

Art Unit

1755

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 16-19, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.                      6) ☐ Other: \_\_\_\_\_

Art Unit: 1755

***Election/Restriction***

Applicants' election with traverse of Group I in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there is no evidence to show that the claimed products are useful as catalysts. This is not found persuasive because applicants should note that their claims recite no more than a filler and a binder. The substances are not even defined. Almost any catalyst composition known is composed of two or more substances that can be categorized as fillers and binders. With respect to comments that catalyst compositions and the coating composition of Group I are in fact materially different, it is pointed out that evidence of this would be the fact that a reference to a coating composition would not normally be combined with a reference to a catalyst to make a rejection because there is no motivation to do so because they are clearly different compositions with different uses. Applicants' comments that no burden exists in searching the entire application are incorrect. Each of the groups and species have completely divergent fields of search. Applicants' comments that there is no reason to support a conclusion that the species are restrictable is not convincing because the fields of search for the species are divergent. Furthermore, different chemicals can be expected to have different effects on the compositions in which they are employed.

Regarding any potential rejoinder, it should be noted that the only time such occurs is when the withdrawn process claims are drawn to a method of making or using an allowable product. Such would not be the case in the instant situation. Group II is

Art Unit: 1755

drawn to a composition, and Group III is actually drawn to a method of using the composition of Group II, irrespective of the dependency of the claims.

Furthermore, not all of the claims of Group II and III depend from the claims of Group I.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

The examiner has not checked the specification to the extent necessary to determine the presence of **all** possible minor errors (grammatical, typographical and idiomatic). Cooperation of the applicant(s) is requested in correcting any errors of which applicant(s) may become aware of in the specification, in the claims and in any future amendment(s) that applicant(s) may file.

Applicant(s) is also requested to complete the status of any copending applications referred to in the specification by their Attorney Docket Number or Application Serial Number, **if any**.

The status of the parent application(s) and/or any other application(s) cross-referenced to this application, if **any**, should be updated in a timely manner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

These claims are indefinite in the recitation of a "coating" because such is an incomplete claim in the absence of a substrate.

Claim 15 employs the improper Markush language "including" which should be replaced with "consisting of".

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 1755

were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,387,364 to Nedelec et al. or U.S. Patent No. 5,486,306 to L'Hostis et al.

Applicants should note that with respect to claim 20, such has been considered to invoke the sixth paragraph of 35 USC 112. Accordingly, the means for binding and the means for rendering the particle hydrophobic are considered to be limited to those set forth in the instant specification and obvious variants. However, as discussed further below, the examination itself has been limited to the elected species

Applicants' claims are drawn to a coating/coating composition comprising a hydrophobic filler and a binder. For the purposes of examination, the elected filler is precipitated silica and the elected binder is PVA. Also elected (for the purposes of searching claim 20) is the means for making the filler hydrophobic, which is silicone oil.

Each of the applied references discloses compositions that contain hydrophobic precipitated silica and PVA, substantially the composition claimed herein by applicants. See columns 5 and 6 of Nedelac et al. and column 4 of L'Hostis et al.

The instantly claimed invention differs from the references in the preamble language "coating" or "coating composition" because it is not considered that such

Art Unit: 1755

recitation adds life and meaning to the claims, nor is such considered to exclude additional substances present in the reference compositions absent a convincing showing of evidence to the contrary.

Claims 1-15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,998,536 to Bertry et al.

Bertry et al. disclose coatings and compositions that contain PVA and precipitated silica. The silicon phase of the material can be silicone oil. See the examples and the claims.

Bertry et al. differ from the instant claims in that other substances may additionally be present in the composition. However, the instant claim language of "comprising" fails to exclude and such additional substances.

Any minor differences in the limitations of the dependent claims have been considered. This statement is meant to include limitations such as the surface area of the silica, which would be expected to be the same as that of commercially available material, or the use of silicone oil to render silica hydrophobic, which is known in the art.

Art Unit: 1755

Furthermore, any such differences are deemed to be result-effective variables that one of ordinary skill in the art would be expected to manipulate to advantage. Additionally, such limitations can be considered to have been simply known as conventional to the artisan practicing in the art at the time the invention was made and/or were common practices which were so well known in the art that they would have been taken for granted. MPEP 706.02(a).

If applicants believe that one or more limitations are critical to the invention, then applicant should amend the claims to reflect such critical limitations as well as indicate where in the specification such critical limitations were discussed and demonstrated.

The limitations of all claims have been considered and are deemed to be within the purview of the prior art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Applicants are advised that any evidence to be provided under 37 CFR 1.131 or 1.132 and any amendments to the claims and specification should be submitted prior to final rejection to be considered timely. It is anticipated that the next office action will be a final rejection.

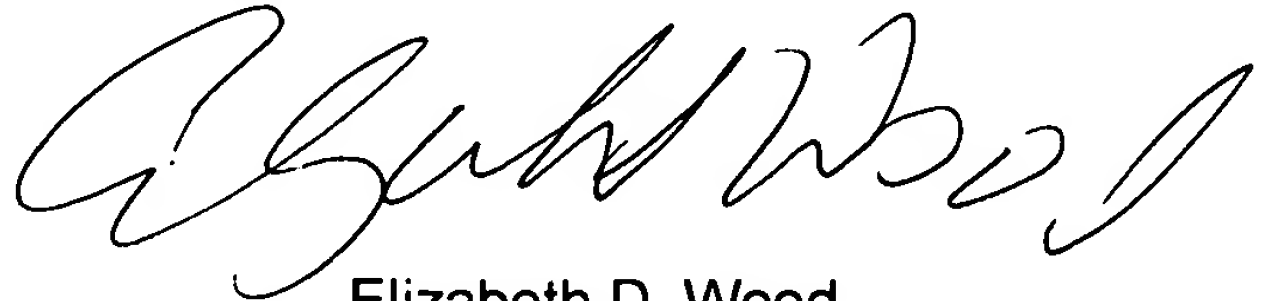


Art Unit: 1755

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth D. Wood whose telephone number is 703-308-3802. The examiner can normally be reached on M-F, 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read 'Elizabeth D. Wood', is positioned above the printed name and title.

Elizabeth D. Wood  
Primary Examiner  
Art Unit 1755

edw